



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/570,299

01/04/2007

Miguel Sigo

251066

7946

23460

7590

01/06/2010

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER

RAPILLO, KRISTINE K

ART UNIT

PAPER NUMBER

3626

NOTIFICATION DATE

DELIVERY MODE

01/06/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com

Chgpatent1@leydig.com

|                              |  |                                    |  |
|------------------------------|--|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/570,299   | <b>Applicant(s)</b><br>SIGO ET AL. |  |
|                              | <b>Examiner</b><br>KRISTINE K. RAPILLO | <b>Art Unit</b><br>3626            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 9/14/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/9/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3626

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment submitted September 14, 2009. Claims 1 - 10 are canceled. Claims 11 - 17 are new.

### ***Claim Rejections - 35 USC § 112***

2. The rejection of Claim 1 under 35 U.S.C. 112, second paragraph, is hereby withdrawn based upon the amendment submitted September 14, 2009.

### ***Claim Rejections - 35 USC § 101***

3. Claims 11 - 17 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a USC §101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. . *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

To qualify as a USC §101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The Applicant recites a "medical information system", however the medical information system is not tied to a server, processor (i.e. a particular machine); thus, the "medical information system" could readily be interpreted as a manual system performed by a person.

There are two corollaries to the machine-or-transformation test. First, a mere field of use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass

Art Unit: 3626

the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, Applicant's method steps fail the first prong of the new test because they are not tied to a particular machine. Further, Applicant's method steps fail the second prong of the test because no underlying subject matter has been transformed.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paradis (U.S. Publication Number 2002/0131572 A1) in view of Jones (U.S. Publication Number 2003/0014284 A1).

In regard to claim 11 (New), Paradis teaches a method for scheduling, via a medical information system, a plurality of exams for a patient, each of said exams requiring at least one resource, the method comprising the following steps:

receiving user input (figures 5 and 6) for:

(a) selecting a first exam from said list (paragraphs 16 and 31) where a task includes surgery, a physical examination, treatment, etc.;

(b) selecting at least one other exam from said list to be co-scheduled with said first exam (paragraph 31) where Paradis discloses sub-tasks related to the main task, such as an x-ray;

(c) scheduling an appointment for said first exam (paragraph 20);

the medical information system checking whether said first and said at least one other exam require the use of a common resource (paragraph 18); and when the result of said checking is positive, applying the scheduled appointment for said at least one other exam (paragraph 20).

Art Unit: 3626

Jones teaches a method comprising: displaying a listing of a plurality of exams having a grouping relation (paragraphs 25, 29, 31, and 34; claim 5) where Jones discloses a physical examination database which lists various groups available for examination, grouped by the system of the human body (i.e. neck, leg).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising: displaying a listing of a plurality of exams having a grouping relation as taught by Jones, within the method of Paradis, with the motivation of providing an efficient and cost effective method of performing a medical examination of a patient (paragraph 25).

In regard to claim 12 (New), Paradis and Jones teach a method according to claim 11.

Jones teaches a method further comprising de-selecting exams from said list for which co-scheduling is not applicable (paragraph 36).

The motivation to combine the teachings of Paradis and Jones is discussed in the rejection of claim 11.

In regard to claim 13 (New), Paradis and Jones teach the method according to claim 11. Paradis teaches a method further comprising the step of assigning to one of said first exam and to said at least one other exam one of a preferred date period and a preferred time period (paragraph 19).

In regard to claim 14 (New), Paradis and Jones teach the method according to claim 11. Paradis teaches a method further comprising the step of assigning to one of said first exam and to said at least one other exam one of a start time and a time interval for starting the exam (paragraph 19).

In regard to claim 15 (New), Paradis and Jones teach the method according to claim 11.

Jones teaches a method further comprising the step of copying information from said first exam to said at least one other exam (paragraph 40).

Art Unit: 3626

The motivation to combine the teachings of Paradis and Jones is discussed in the rejection of claim 11.

In regard to claim 16 (New), Paradis and Jones teach the method according to claim 11. Paradis teaches a method further comprising the step of generating a confirmation letter for said first exam (paragraphs 20, 22, and 31) where a patient electronically confirms acceptance of an appointment.

In regard to claim 17 (New), Paradis and Jones teach the method of claim 16. Paradis teaches a method wherein said confirmation letter comprises information for said at least one other exam (paragraphs 20, 22, and 31) where a patient electronically confirms acceptance of an appointment.

### ***Response to Arguments***

6. Applicant's arguments filed September 14, 2009 are moot as claims 1 – 10 are canceled and claims 11 – 17 are new.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3626

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/C. Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626